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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,885	03/22/2004	John W. Benbow	PC25078A	2214
28523	7590	09/26/2006	EXAMINER	
PFIZER INC. PATENT DEPARTMENT, MS8260-1611 EASTERN POINT ROAD GROTON, CT 06340			TUCKER, ZACHARY C	
			ART UNIT	PAPER NUMBER
			1624	

DATE MAILED: 09/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/805,885	Applicant(s) BENBOW ET AL.	
	Examiner Zachary C. Tucker	Art Unit 1624	1 of 2

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 September 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: _____.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.



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Continuation of 11. does NOT place the application in condition for allowance because: Claim 1 is rejected as new matter because the variables Ra, Rb and R1, by the new proviso, are tied together in a relationship NOT described in the originally filed disclosure. Simply because "halogen" is one of the choices in the definitions of R1 and R2 is not enough to provide support for the new proviso. Applicants should note that all of Ra, Rb, R1 and R2 are INDEPENDENTLY selected from the choices provided in the definitions therefor. The new proviso, however, establishes a relationship between those variables that is not described in the written description.

The cited case law in applicants' argument is noted. Decisions in both cited cases turned on whether or not applicants had possession of the invention as specified in the claim as newly drafted, with the proviso alleged by the Office to not be supported in the written description. The Board and the court found in *Ex parte Park* and in *In re Johnson*, respectively, that if applicants had exemplified the embodiments excluded by the new proviso, then said proviso was indeed supported in the written description, even though the proviso was not laid out *ipsis verbis* in the specification. Applicants, in the instant case, cannot say that the excluded embodiments are exemplified fully, like as was the case with *Parks* and *Johnson*. Only two compounds would fall within the proviso which has been deemed new matter - the compounds of Examples 46 and 48. In Example 46, Rb is isopropyl and R1 is bromo-, while in Example 48, Rb is isopropyl while R1 is chloro-. The proviso in instant claim 1 is BROADER than what applicants have support for. The examiner concludes that applicants have support in the written description, based on the cited case law, ONLY for a more limited new proviso, which would appear AFTER the proviso in claim 1 as originally filed, which would read, "...and further provided that when Ra is hydrogen and Rb is isopropyl, R1 is not bromo or chloro..." There is NO support in the exemplified embodiments of the invention for the full scope of the proviso as it appears in amended claim 1 as of 13 July 2006, because no compounds wherein R1 is an iodine atom are exemplified, and also because no compounds wherein both Ra and Rb are hydrogen and R1 is ANY halogen are exemplified. So, in light of the cited case law, applicants have no support in the disclosure for the new proviso in claim 1, which has been properly rejected under the first paragraph of 35 U.S.C 112.